

REMARKS/ARGUMENTS

Claims 14-25 remain in the application, all of which stand rejected. Claims 1-13 have been canceled.

1. Finality of Office Action Believed to be Premature

In an Office Action mailed September 19, 2007, the Examiner rejected applicant's claims 14-19 under 35 USC 102(e) as being anticipated by Organ et al. ("Organ"). The Examiner asserted, in part, that Organ discloses "logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license". In an Amendment dated January 21, 2008, applicant responded to this part of the Examiner's rejection by arguing that Organ did not teach the particular "logic" recited in claim 14.

In an Office Action mailed April 21, 2008, the Examiner indicated that applicant's January 21st argument was "not persuasive". However, to the contrary, applicant believes their argument was *persuasive*. This is because the Examiner altered the basis for rejecting claims 14-19. Specifically, the Examiner moved away from a straight-forward 35 USC 102(e) rejection of applicant's claims 14-19 and took a new position regarding claim 14's limitation of "logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license". That is, the Examiner no longer asserts that Organ teaches logic "to enable one or more resources of the tester according to one or more properties of an electronic license", but instead asserts that 1) this limitation merely recites an intended use for the recited "logic", and 2) the recitation of an intended use is given "little patentable weight" because "the recitation of a new intended use of an old product does not make a claim to that old product patentable." The Examiner further indicates that, "Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending." See, 4/21/2008 Final Office Action, pp. 2-3.

As a result of the above change in the basis for rejecting claims 14-19, and because the change was not necessitated by any claim amendment on applicant's part, applicant asks that the finality of the April 21, 2008 Office Action be withdrawn.

2. Rejection of Claims 14-25 Under 35 USC 102(e)

Claims 14-25 stand rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368; hereinafter "Organ").

With respect to claim 14, the Examiner asserts that:

...Organ discloses a tester to apply to one or more testers to a device (see abstract - an electronic tester; a test head is coupled to a device under test), logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license (i.e. rule) (see col. 12, lines 4-6) and to create at least one log file having resources use information for one or more tests executed on the tester (see col. 14, lines 46-50).

4/21/2008 Final Office Action, p. 3.

Applicant respectfully disagrees. Organ's col. 12, lines 4-6, recites:

When a program is loaded, the information is resolved into specific attributes of the selected tester. Tester resource allocation and **rules** checking is performed at this time.

(Emphasis added)

The above is Organ's only mention of "rules". Applicant asserts that nothing in the above excerpt mentions or implies that "rules checking" includes license checking. Nor does the above excerpt mention or imply that Organ utilizes an "electronic license" to enable one or more resources of a tester. Further, it is noted that Organ's disclosure does not mention a "license" or "licensing" even once. As a result, applicant asserts that Organ is devoid of any teaching or suggestion of "logic."

.to enable one or more resources of [a] tester according to one or more properties of an electronic license". Claim 14 is believed to be allowable for at least this reason.

The argument set forth above was first made in applicant's Amendment dated January 21, 2008. In the Examiner's 4/21/2008 Final Office Action, the Examiner responded to applicant's argument by asserting that the phrase "to enable one or more resources of [a] tester according to one or more properties of an electronic license" was merely a recitation of a new intended use for an old product (i.e., a new intended use for Organ's apparatus). Applicant respectfully disagrees.

The Examiner cites *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) for the proposition that "the recitation of a new intended use of an old product does not make a claim to that old product patentable." However, the claims at issue in *Schreiber* were directed to a simple mechanical device - i.e., a generally conical shaped device for dispensing popcorn. In *Schreiber*, the court found that Schreiber's claim to a generally conical shaped device for dispensing popcorn was anticipated by a generally conical shaped device for dispensing oil. The court also found that the conical shaped device for dispensing oil would inherently be able to perform Schreiber's function of "dispensing popcorn".

In contrast to the simple mechanical device that was at issue in *Schreiber*, applicant's claim 14 recites a system comprising "a tester" and "logic, communicatively coupled to the tester". Applicant's claim 14 also recites some functions that are performed by the logic. Nowhere does Organ teach or suggest that such functions are performed (inherently or otherwise) by any element of Organ's apparatus. At a minimum, the performance of the functions recited by applicant's claim 14 would require a reprogramming or reconfiguration of Organ's apparatus so that it could perform the new functions of applicant's claim 14. In other words, Organ's apparatus is not inherently capable of performing the functions of applicant's claimed "logic". As a result, applicant believes *Schreiber* is factually distinguishable from the case at hand, and is not applicable.

If the Examiner's position represented the position of the Office, then Beauregard-type claims would not be patentable, because "computer readable media" already exists, and the functions performed by any sort of computer readable

code that was stored on the computer readable media would not result in any structural difference being imparted to the computer readable media itself.

Applicant further asserts that, unlike the claimed mechanical device in Schreiber, which was identical to a prior art device, but used in a new way, applicant's claimed "logic", at a minimum, would have to be physically programmed in a way that is not disclosed or suggested by Organ. As a result, applicant asks that the Examiner give equal patentable weight to all of the limitations set forth in claim 14.

The Examiner also rejects claim 14 on the basis that Organ, in col. 14, lines 46-50, discloses "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester". Organ's col. 14, lines 46-50, recites:

. . .Button number 228 of operator tool 160 allows the user to turn on or turn off the enVision++ data log. When the envision data log is turned on, the measurements made during digital testing of DUT 50 are written to a file.

Area 239 of operator tool 160 is used to display status.

Applicant asserts that nothing in the above excerpt teaches the creation of a log file having "resource use information". That is, the enVision++ **data log** is only a "data log", or a log of "measurements made during digital testing". Organ does not indicate or suggest that the enVision++ log should additionally or alternately be used to log "**resource use information**", as recited in applicant's claim 14. Claim 14 is therefore believed to be allowable for this additional reason.

Of note, the Examiner has not responded to applicant's above argument concerning the failure of Organ to disclose "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester".

Claims 15-25 are believed to be allowable, at least, because they depend from claim 14.

3. Conclusion

In light of the amendments and remarks provided herein, applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,
HOLLAND & HART, LLP

By: 

Gregory W. Osterloth
Reg. No. 36,232
Tel: (303) 295-8205